



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/739,448 | 12/18/2000 | Jerome Dale Johnson | P65332 | 3475 |
| 40401 7590 08/06/2008 Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314 | | | | |
| EXAMINER | | | | |
| PASS, NATALIE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3626 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 08/06/2008 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@hershkovitz.net
patent@hershkovitz.net

Office Action Summary

Application No.

09/739,448

Applicant(s)

JOHNSON ET AL.

Examiner

Natalie A. Pass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 20-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 20-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 29 April 2008. Claims 1, 11, 30, 50-52, have been amended. Claims 12-19 have been previously cancelled. Claims 1-11, 20-52 are currently pending.

Claim Rejections - 35 USC § 112

2. The rejection of claims 50-52 under 35 U.S.C. 112, first paragraph, for containing new matter is hereby withdrawn due to the amendment filed 29 April 2008.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for substantially the same reasons given in the prior Office Action (paper number 20071017).

(A) Claims 1, 50-52 continue to recite “... presenting [present] a description of insurance plan options available to the customer...” on lines 11, 13, 15, 18-19, which appear to recite presenting a description of only those plans that are available to the customer, however claims 1, 50-52 also recite “the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer ... [...]” It remains unclear how within a description of insurance plan options available to the customer can be included an indication that a plan has been determined to be not available.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 20-27, 30-47, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 in view of Warady, U.S. Patent Number 6, 067, 522 for substantially the same reasons given in the prior Office Action (paper number 20071017), and further in view of Tyler, U.S. Patent Number 5, 523, 942. Further reasons appear hereinbelow.

- (A) Claims 1, 11, 30 and 50-52 have been amended to include the recitation of
- “wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal” in lines 22-24, 25-27, 25-27, 26-28, 27-29, and 29-31, respectively.

As per these new limitations Lockwood and Warady teach a method for generating a customized proposal in the development of insurance plans for a customer (Lockwood; column 6, lines 3-11), as analyzed and discussed in the previous Office Action (paper number 20071017).

Lockwood and Warady fail to explicitly disclose

wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal.

However, the above features are well-known in the art, as evidenced by Tyler.

In particular, Tyler teaches

wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal (Tyler; Abstract, column 4, line 65 to column 5, line 40, column 6, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood and Warady to include these limitations, as taught by Tyler, with the motivations of “design[ing] an insurance product for a customer ... [...] ... receiving a request for information about an insurance product or policy ... [...] ... accessing stored information, such as rates, performing the necessary calculations based on the request and returning the requested information to the user” (Tyler; column 5, lines 32-38) and providing a “uniform approach ... [...] ... in which one user interface can be used to enter information about all possible products, and where the calculations that are performed are designed based on the operations that take place” (Tyler, column 4, lines 56-62).

The remainder of claims 1, 11, 30 and 50-52 is rejected for the same reasons given in the prior Office Action (paper number 20071017, section 9, pages 5-19), and incorporated herein.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 in the previous Office Action (paper number 20071017), and incorporated herein.

(B) Claims 2-10, 20-27, 31-47 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20071017, section 9, pages 5-19), and incorporated herein.

7. Claims 28-29, 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359, Warady, U.S. Patent Number 6, 067, 522, and Tyler, U.S. Patent Number 5, 523, 942, as applied to claim 1 above, and further in view of Gamble, et al., U.S. Patent Number 6, 163, 770 for substantially the same reasons given in the prior Office Action (paper number 20071017). Further reasons appear hereinbelow.

(A) Claims 28-29, 48-49 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20071017, section 10, pages 19-21), and incorporated herein.

Response to Arguments

8. Applicant's arguments filed 29 April 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 29 April 2008.

(A) At pages 15-18 of the 29 April 2008 response Applicant argues the rejections of claims 50-52 under 35 U.S.C. 112, first paragraph. These arguments are persuasive, and accordingly this rejection has been withdrawn.

(B) At pages 18-19 of the 29 April 2008 response Applicant argues the rejections of claims 1, 50-52 under 35 U.S.C. 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However, claims 1 and 50-52 continue to recite "... presenting [present] a description of insurance plan options available to the customer ...," (emphasis added), which appear to recite presenting a description of only those plans that are available to the customer; however claims 1, 50-52 also recite "the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer ... [...]" It remains unclear how within a description of insurance plan options available to the customer can be included an indication that a plan has been determined to be not available. Furthermore, as per Applicant's arguments that "[t]he claims are clear that a plan may be offered but was not offered to the customer because it was not customized, meant that if a plan was not offered to a customer, it was therefore not available to the customer," Examiner respectfully disagrees that the claims are clear, and further notes that these are not claimed limitations. Moreover, as regards the claimed limitation "the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer," Examiner broadly interprets the claim to mean that a plan may not be available to a customer for a variety of reasons, including, for example, the customer's ineligibility for the plan, and not solely "because the plan was not customized" for the customer, as argued by Applicant.

(C) As per Applicant's arguments on pages 19-21 of the response filed 29 April 2008 regarding the rejections under 35 U.S.C. 103(a) of claims 1-11, 20-52, these arguments are moot in view of the new grounds of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please label

"PROPOSED" or "DRAFT" on the front page of the

communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. A. P./
Examiner, Art Unit 3626
August 4, 2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626